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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,276	11/02/2005	Richard Jeffery	36-1926	4593

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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER	
ELPENORD, CANDAL	
ART UNIT	PAPER NUMBER
2416	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/555,276	JEFFERY ET AL.	
	Examiner	Art Unit	
	CANDAL ELPENORD	2416	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 November 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *January 23, 2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed December 01, 2008 with respect to the U.S.C 112 2nd rejections in regard to claims 1-18 have been fully considered but they are not persuasive.

In response, the Examiner respectfully disagrees with assertions made by the Applicant that MPEP does not support rejection for the phrase "capable of" because it gives to certain ambiguity.

Applicant's arguments, see After Final amendment, filed December 01, 2008, with respect to the final office have been fully considered and are persuasive. The finality of the last office action has been withdrawn.

Note: in withdrawing the last Final Action due to the alleged new ground of rejection, the Examiner does not acquiesce to the Applicant arguments with respect to the obvious rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 3, 10, 13 the phrase "capable of" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 2, 4-9, 11, 14-18 are rejected due to their dependency on claims 1, 10 respectively.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 1-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mighdoll et al (US 6,332,157 B1) in view of Kaplan et al (US 6,016,307).

Regarding claim 1, Mighdoll '157 discloses system (fig. 1, WebTV system that provides access to plurality of service providers, col. 4, lines 30-57) for selecting a preferred data provider from a plurality of data providers (see, server system with means for providing the client system to access and select a number of service providers, col. 2, lines 43-50), the system (fig. 1, WebTV system that provides access to plurality of service providers, col. 4, lines 30-57) comprising: means for receiving a request for data (see, receiving request from the client for a particular service, col. 3, lines 1-7) from a client (fig. 1, see WebTV Client 1); means for receiving client identification data from said client (fig. 1, see means for receiving the identification of client, col. 3, lines 1-7, col. 2, lines 58-67); means for identifying a plurality of data providers capable of providing data to said client (see, service name identifying the service providers that are able to provide the desired service request, col. 2, lines 58-67, col. 3, lines 1-7); means for providing said client identification data to said data providers (fig. 1, see the WebTV server using the identification of the client to provide WebTV services, col. 5, lines 54-62); means for instructing said data providers (noted:

instruction means executed by processor, col. 4, lines 20-28) to perform the steps without requiring the client to install or execute additional software at the client (noted: downloading of the of streaming data to the client in which the client does not run or execute any type of control, col. 8, lines 4-14): (i) sending a test signal to said client; (ii) receiving a return signal from said client; (iii) obtaining a measure of the elapsed time between the sending of the test signal and the receipt of the return signal; (iv) making a signal indicative of the elapsed time available to the system; and v) making a signal indicative of their remaining capacity available to the system; means for receiving elapsed time signals and remaining capacity signals from said data providers; means for selecting a preferred data provider on the basis of said signals; and means for providing information relating to the identity of said preferred data provider to said client (see, service name identifying the service provider that is able to provide the desired service request, col. 2, lines 58-67, col. 3, lines 1-7).

Regarding claim 10, Mighdoll '157 discloses Method for selecting a preferred data provider from a plurality of data providers (fig. 1, WebTV system and method that provide access to plurality of service providers, col. 4, lines 30-57), the method (fig. 1, WebTV system and method that provide access to plurality of service providers, col. 4, lines 30-57) comprising the steps of: receiving a request for data (see, receiving request from the client for a particular service, col. 3, lines 1-7) from a client (fig. 1, see WebTV Client 1); receiving client identification data from said client (fig. 1, see means for receiving the identification of client, col. 3, lines 1-7, col. 2, lines 58-67); identifying a plurality of data providers capable of providing data to said client (see, service name

identifying the service providers that are able to provide the desired service request, col. 2, lines 58-67, col. 3, lines 1-7); providing said client identification data to said data providers (fig. 1, see the WebTV server using the identification of the client to provide WebTV services, col. 5, lines 54-62); instructing said data providers (noted: instruction means executed by processor, col. 4, lines 20-28) to perform the following steps without requiring the client to install or execute additional software at the client (noted: downloading of the of streaming data to the client in which the client does not run or execute any type of control, col. 8, lines 4-14): providing information relating to the identity of said preferred data provider to said client (see, service name identifying the service provider that is able to provide the desired service request, col. 2, lines 58-67, col. 3, lines 1-7).

Regarding claims 2, **11** Mighdoll '157 discloses a system (fig. 1, WebTV system that provides access to plurality of service providers, col. 4, lines 30-57), wherein the means for receiving a request for data comprises means for receiving a request for one or more specific items (noted: e-mail service request, video services, col. 3, lines 1-16, col. 5, lines 12-19).

Regarding claims 3, **12**, Mighdoll '157 discloses a system (fig. 1, WebTV system that provides access to plurality of service providers, col. 4, lines 30-57), wherein the means for identifying data providers comprises means for searching for data providers capable of providing the specific item or items requested (see, service name identifying the service provider that is able to provide the desired service request

(i.e. e-mail service, multimedia service such as video) col. 2, lines 58-67, col. 3, lines 1-7).

Regarding claims 4, **13**, Mighdoll '157 discloses a system (fig. 1, WebTV system that provides access to plurality of service providers, col. 4, lines 30-57), wherein the selecting means is arranged to select a preferred data provider from data providers see, server system with means for providing the client system to access and select a number of service providers, col. 2, lines 43-50) having a remaining capacity above a predetermined threshold (noted: selecting an alternate service provide that is not overload to provide the requested service based on the bandwidth, col. 2, lines 50-57).

Regarding claims 5, **14**, Mighdoll '157 discloses a system (fig. 1, WebTV system that provides access to plurality of service providers, col. 4, lines 30-57), wherein the means for instructing said data providers (noted: instruction means executed by processor, col. 4, lines 20-28).

Regarding claims 6, **15**, Mighdoll '157 discloses a system (fig. 1, WebTV system that provides access to plurality of service providers, col. 4, lines 30-57), wherein the means for instructing said data providers (noted: instruction means executed by processor, col. 4, lines 20-28) is a means remote from the client (fig. 1, see the WebTV server 5 with means for instructing the service providers (i.e. Remote servers 4) which remote form the WebTV client, col. 4, lines 30-57, col. 5, lines 54-62).

Regarding claims 7,**16**, Mighdoll '157 discloses a system (fig. 1, WebTV system that provides access to plurality of service providers, col. 4, lines 30-57), wherein the means for providing information relating to the identity of the preferred data provider (noted: providing the information identifying the service providers, col. 2, lines 58-67). is arranged to provide said information on a web site (see, selecting the service provide based on the URL identification of the service provider, col. 3, lines 11-16).

Regarding claims 8, **17**, Mighdoll '157 discloses a system (fig. 1, WebTV system that provides access to plurality of service providers, col. 4, lines 30-57), wherein the means for providing information relating to the identity of the preferred data provider is arranged to provide the Uniform Resource Locator (URL) of said preferred data provider (see, selecting the service provide based on the URL identification of the service provider, col. 3, lines 11-16).

Regarding claims 9, **18**, Mighdoll '157 discloses a system (fig. 1, WebTV system and method that provide access to plurality of service providers, col. 4, lines 30-57), comprising means capable of selecting more than one preferred data provider according to predetermined criteria (see, selecting of another service provider when the first selected service provider does not have the required capacity to provide the requested service, col. 2, lines 50-57, abstract), and means for providing information relating to the identity of each preferred data provider to the client (noted: providing the information identifying the service providers, col. 2, lines 58-67).

Regarding claim 10, Mighdoll '157 discloses Method for selecting a preferred data provider from a plurality of data providers (fig. 1, WebTV system and method that provide access to plurality of service providers, col. 4, lines 30-57), the method (fig. 1, WebTV system and method that provide access to plurality of service providers, col. 4, lines 30-57) comprising the steps of: receiving a request for data (see, receiving request from the client for a particular service, col. 3, lines 1-7) from a client (fig. 1, see WebTV Client 1); receiving client identification data from said client (fig. 1, see means for receiving the identification of client, col. 3, lines 1-7, col. 2, lines 58-67); identifying a plurality of data providers capable of providing data to said client (see, service name identifying the service providers that are able to provide the desired service request, col. 2, lines 58-67, col. 3, lines 1-7); providing said client identification data to said data providers (fig. 1, see the WebTV server using the identification of the client to provide WebTV services, col. 5, lines 54-62); instructing said data providers (noted: instruction means executed by processor, col. 4, lines 20-28) to perform the following steps without requiring the client to install or execute additional software at the client (noted: downloading of the of streaming data to the client in which the client does not run or execute any type of control, col. 8, lines 4-14): providing information relating to the identity of said preferred data provider to said client (see, service name identifying the service provider that is able to provide the desired service request, col. 2, lines 58-67, col. 3, lines 1-7).

Mighdoll '157 discloses all the claimed limitations as set forth above with the exception of being silent with respect to claimed features:

Regarding claim 1, (i) sending a test signal to said client; (ii) receiving a return signal from said client; (iii) obtaining a measure of the elapsed time between the sending of the test signal and the receipt of the return signal; (iv) making a signal indicative of the elapsed time available to the system; and v) making a signal indicative of their remaining capacity available to the system; means for receiving elapsed time signals and remaining capacity signals from said data providers; means for selecting a preferred data provider on the basis of said signals; and means for providing information relating to the identity of said preferred data provider to said client.

Regarding claim 10, (i) sending a test signal to said client; (ii) receiving a return signal from said client; (iii) obtaining a measure of the elapsed time between the sending of the test signal and the receipt of the return signal; (iv) making a signal indicative of the elapsed time available to the system; and v) making a signal indicative of their remaining capacity available to the system; means for receiving elapsed time signals and remaining capacity signals from said data providers; means for selecting a preferred data provider on the basis of said signals; and means for providing information relating to the identity of said preferred data provider to said client.

However Kaplan '307 from the same field of endeavor discloses the above claimed features:

Regarding claim 1, (i) sending a test signal to said client (see, measuring means (i.e. round-trip, elapsed time, bandwidth on the path) parameter of the telecommunications paths using ping test, col. 3, lines 19-22 ; (ii) receiving a return signal from said client (fig. 1, see path analysis block with means for returning and using the measured parameter (i.e. elapsed time, latency along the path), col. 3, lines 36-41, col. 4, lines 58-60, col. 6, lines 1-9); (iii) obtaining a measure of the elapsed time between the sending of the test signal and the receipt of the return signal (see, path analysis block with sending a ping to obtain the characteristics (i.e. elapsed time, latency along the path) of the path, col. 6, lines 1-9); (iv) making a signal indicative of the elapsed time available to the system (fig. 1, see the path analysis block returning the measured parameters to the route optimization means which is part of the telecommunication system, col. 6, lines 1-9, col. 7, lines 49-57); and v) making a signal indicative of their remaining capacity available to the system (fig. 1, see the path analysis block returning the measured available bandwidth from the LAN, Wireless, and POTS service providers back to the system, col. 6, lines 1-9, col. 7, lines 49-57); means for receiving elapsed time signals and remaining capacity signals from said data providers (fig. 1, see the path analysis block returning the measured signals from the service providers such as latency time, available bandwidth, col. 6, lines 1-9, col.7, lines 49-57); means for selecting a preferred data provider on the basis of said signals (noted: selecting a LAN, WAN, Wireless, POTS service providers based on measured parameters (i.e. path analysis-round-trip, elapsed time, available bandwidth), col. 7, lines 49-57).

Regarding claims 5, **14,** comprises means for instructing the data providers to make available to the system a signal indicative of their remaining bandwidth (fig. 1, see the path analysis block returning the measured available bandwidth from the LAN, Wireless, and POTS service providers back to the system, col. 6, lines 1-9, col. 7, lines 49-57).

Regarding claim 10, (i) sending a test signal to said client (see, measuring means (i.e. round-trip, elapsed time, bandwidth on the path) parameter of the telecommunications paths using ping test, col. 3, lines 19-22 ; (ii) receiving a return signal from said client (fig. 1, see path analysis block with means for returning and using the measured parameter (i.e. elapsed time, latency along the path), col. 3, lines 36-41, col. 4, lines 58-60, col. 6, lines 1-9); (iii) obtaining a measure of the elapsed time between the sending of the test signal and the receipt of the return signal (see, path analysis block with sending a ping to obtain the characteristics (i.e. elapsed time, latency along the path) of the path, col. 6, lines 1-9); (iv) making a signal indicative of the elapsed time available to the system (fig. 1, see the path analysis block returning the measured parameters to the route optimization means which is part of the telecommunication system, col. 6, lines 1-9, col. 7, lines 49-57); and v) making a signal indicative of their remaining capacity available to the system (fig. 1, see the path analysis block returning the measured available bandwidth from the LAN, Wireless, and POTS service providers back to the system, col. 6, lines 1-9, col. 7, lines 49-57); means for receiving elapsed time signals and remaining capacity signals from said data providers (fig. 1, see the path analysis block returning the measured signals from

the service providers such as latency time, available bandwidth, col. 6, lines 1-9, col.7, lines 49-57); means for selecting a preferred data provider on the basis of said signals (noted: selecting a LAN, WAN, Wireless, POTS service providers based on measured parameters (i.e. path analysis-round-trip, elapsed time, available bandwidth), col. 7, lines 49-57).

In view of the above, having the server system for selecting among a plurality of service providers of Mighdoll '157, and the teaching features of Kaplan '307, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching features of Mighdoll '157 by using features as taught by Kaplan '307 in order to provide selection of transmission of telecommunication path based on determined parameters (i.e. available bandwidth, latency time).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Higgins et al (US 5,953,350) and Dziekan et al (US 6,704,288 B1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CANDAL ELPENORD whose telephone number is (571)270-3123. The examiner can normally be reached on Monday through Friday 7:30AM to 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kwang Bin Yao can be reached on (571) 272-3182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Candal Elpenord/

Examiner, Art Unit 2416

/Kwang B. Yao/
Supervisory Patent Examiner, Art Unit 2416